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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/800,886	03/15/2004	Octave E. Lord	LOE-100-A	1956

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EXAMINER

ARK, DARREN W

ART UNIT	PAPER NUMBER
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3643

DATE MAILED: 05/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/800,886

Applicant(s)

LORD, OCTAVE E.

Examiner

Darren W. Ark

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10-13, 16, 17, 19 and 20 is/are rejected.
- 7) ☒ Claim(s) 9, 14, 15 and 18 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 March 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION***Drawings***

1. The drawings are objected to because the entire device shown in Figs. 1 and 2 does not represent a "downrigger counter device 1" but instead represents a downrigger system with a downrigger counter device which is a part of the downrigger system.

There should be further reference numbers pointing out the other parts of the downrigger system which pertain to setting the fishing line out and not to the counting device such as the reel, boom, rod holder, etc. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

2. The disclosure is objected to because of the following informalities: the specification should refer to the downrigger counter device as part of a downrigger system since the downrigger counter device is merely a part of the overall downrigger system. The specification should also include reference numbers denoting the other parts of the downrigger system including the reel, boom, rod holder, etc. so that a distinction is made between the desired invention and the common downrigger equipment.

Appropriate correction is required.

Claim Objections

3. Claims 14, 18 are objected to because of the following informalities:

Claim 14, line 2, the term "said light assembly" is unclear since there does not appear to be a previous occurrence of this term in any of claims 1, 5, and 14.

Claim 18, lines 2 and 3, the term "said fiberoptic connection" is unclear since "a first fiberoptic connection" and "a second fiberoptic connection" were set forth previously in claim 9.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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5. Claims 3, 4, 7, 8, 10-13, 16, 17, 19, 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In regard to claim 3, lines 6 and 9, the term "said downrigger counter" lacks positive antecedent basis "at least one downrigger counter" was previously set forth in line 4 and this term fails to refer back to "at least one downrigger counter". Also see claim 4, lines 2, 9, and 10 for the same problem.

In regard to claim 8, the term "a downrigger counter" renders the claim vague and indefinite since "at least one downrigger counter" was previously set forth in claim 4 and this term fails to refer back to "at least one downrigger counter".

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, 2 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by King 4,050,180.

King discloses a downrigger board assembly (12, 13 or 80); at least one downrigger counter (36); lighting means (see circuit diagram of Fig. 8 with light bulb shown; light can travel from the area of 60 toward 36, no specific intensity is recited).

8. Claims 1, 2, 5, 6 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Landell et al. 4,691,470.

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Landell et al. discloses a downrigger board assembly (20; assembly is not being particularly recited); at least one downrigger counter (ruler on 20 in Figs. 1, 2, 4); lighting means (38).

In regard to claims 5 and 6, Landell et al. discloses a counter at each end (ruler has portions at each end of 20).

9. Claims 1, 2 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Adams et al. 4,422,258.

Adams et al. discloses a downrigger board assembly (10; assembly is not being particularly recited); at least one downrigger counter (35; counter not being particularly claimed); lighting means (42-44).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 5, 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over King 4,050,180.

Alternatively, King discloses a single counter on one end of the board assembly, but does not disclose a downrigger counter on a downrigger counter at each end of the downrigger board assembly. It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ a downrigger counter at each end of the downrigger board assembly, since it has been held that mere duplication of the

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essential working parts of a device involves only routine skill in the art, and because a counter on each end of the downrigger board assembly would allow the user to easily view the depth counter from multiple positions so as to be able to view depth indication at the closest one. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

12. Claims 5, 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over King 4,050,180 in view of Booth et al. 4,000,653.

Alternatively, King discloses a single counter on one end of the board assembly, but does not disclose a downrigger counter on a downrigger counter at each end of the downrigger board assembly. Booth discloses in Fig. 7 a system for providing an indication of the length of control line payed out at a remote location where it is desired to be viewed by the user. It would have been obvious to a person of ordinary skill in the art to modify the downrigger board assembly of King such that it has a counter at each end thereof in view of Booth et al. in order to provide the user with the necessary access to the information displayed by the counter at the desired location close to the user.

Allowable Subject Matter

13. Claims 9, 14, 15, and 18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

14. Claims 3, 4, 7, 8, 10-13, 16, 17, 19, and 20 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

Response to Arguments

15. Applicant's arguments filed 3/17/2005 have been fully considered but they are not persuasive.

In regard to applicant's argument that "King... shows no light bulb", the Examiner contends that in Fig. 8 of King there is shown an unlabelled resistor which is enclosed by a housing that represents a light bulb.

In regard to applicant's argument that "Landell... is not a downrigger counter board assembly... merely is a tray..." and that "Adams... casing 10 does not constitute a downrigger board assembly... hull 35... a downrigger counter...", the Examiner contends that there is insufficient structure being recited in the rejected claims to define over the structure as disclosed by Landell and Adams et al. Furthermore, the structure of either Landell or Adams et al. can be interpreted as a downrigger board assembly since there is no further language which distinguishes the downrigger counter board assembly of the desired invention and also such structure as the reel or boom of the downrigger assembly is not being recited to define over the Landell tackle box or Adamst et al. signaling device mounted on a fishing rod.

Conclusion

16. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Darren W. Ark whose telephone number is (571) 272-6885. The examiner can normally be reached on M-Th, 8:00am-6:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter M. Poon can be reached on (571) 272-6891. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Darren W. Ark
Primary Examiner
Art Unit 3643

DWA